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Remarks

Claim 1 is canceled to expedite further prosecution of this application. Previously withdrawn claims 2-9, 13, 14 and 16-35 are canceled as well.

Claims 10-12, 15 and 36 are pending and are under consideration.

The rejection of claims 10-12, 15 and 36 under 35 U.S.C. 103(a) as unpatentable over Marino et al. in view of newly cited U.S. Patent 5,885,287 to Bagby is not warranted, and is hereby traversed.

As pointed out in response to the previous Office Action, Marino et al. fail to disclose the claimed invention. It is noted that the Examiner concedes that Marino et al. does not disclose a "complete cylindrical body and helical external threads." Indeed, Marino et al. do not even suggest a cylindrical body of any kind inasmuch as a cylindrical body cannot be provided with the necessary camming surfaces 28 and 30 (col. 8, lines 50-56; see also FIGS. 11-13) called for by Marino et al. The device shown by Marino et al. cannot be deemed cylindrical by any stretch of the imagination. Accordingly, Marino et al. do not disclose the present invention "substantially as claimed."

For the foregoing reasons the Bagby device, and any features thereof, are not combinable with Marino et al. because a cylindrical configuration would necessarily defeat the very purpose of Marino et al.'s purported invention. See, for example, Marino et al. at col. 2, lines 20-35. It is impossible for the cylindrical body shown by Bagby to provide outwardly facing, convexly curved camming surfaces for moving apart adjacent vertebrae as taught by Marino et al. See also FIGS. 11 and 12 of Marino et al. One of ordinary skill would not have even attempted to do so. The teachings of Marino et al. and Bagby clearly are incompatible with one another.

The applied prior art references also fail to provide the necessary evidentiary support to justify the attempted combination. Lack of such evidentiary support constitutes impermissible hindsight. Here the attempted combination of selected features from Marino et al. and Bagby evidences liberal, albeit impermissible, attempt at hindsight reconstruction of the claimed invention using applicants' own specification as a guide. In re Fine, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988).

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Here the Examiner has been unable to point to any teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to the modifications proposed by the Examiner.

The legal standard for obviousness under 35 U.S.C. 103(a) has been reiterated recently by the U.S. Supreme Court in KSR Int'l v. Teleflex, Inc., 82 U.S.P.Q.2d 1385 (2007).

According to the KSR decision, the applicable standards are those factual inquiries identified in Graham v. John Deere Co., 383 U.S. 1, 17, 148 U.S.P.Q. 459 (1966), to wit:

- (1) determining the scope and contents of the prior art;
- (2) ascertaining the differences between the prior art and the claims under consideration;
- (3) resolving the level of ordinary skill in the pertinent art or technological areas; and
- (4) evaluating evidence of secondary considerations.

See also MPEP §2141.

Regarding Factual Inquiry (1), the applied prior art is directed to a camming device for spreading adjacent vertebrae (Marino et al.) and to a cylindrical vertebrae interbody fusing device (Bagby). In contradistinction, the claimed invention is a spinal stabilization device for insertion into a degenerated spinal disc that does not immobilize the spine but provides more normal spinal movement.

Regarding Factual Inquiry (2), instead of ascertaining the differences between the prior art and the claims, the Examiner has sought to emphasize similarities. The configuration of the Marino et al. device does not even come close to cylindrical. The Bagby device is much too large to be received into a spinal disc passageway. Instead, it is introduced and fixed into bone beds 28 and 30 (See Fig. 1).

Regarding Factual Inquiry (3), the level of ordinary skill in the pertinent art has not been resolved. There are no findings of fact of record that establish this skill level.


The onus in the first instance is on the Examiner to establish a *prima facie* case of obviousness. Clearly that has not been done here. Withdrawal of the outstanding rejection is believed to be in order.

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The foregoing amendments to the claims and the accompanying discussion are deemed to dispose of all issues in this case and to place this application in condition for allowance. Early such action is solicited.

Respectfully submitted,

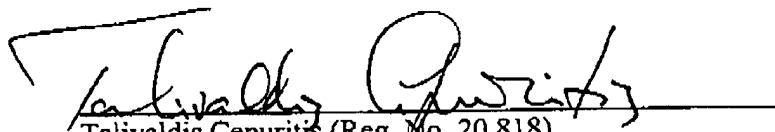
June 16, 2008

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CERTIFICATE OF FACSIMILE TRANSMISSION

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